

### **REMARKS**

Claims 1-5, 7-10, 13, 16-17 and 19-32 were previously pending, of which claims 16-17, 28 and 31-32 have been canceled and claims 1, 20-27, and 29-30 have been amended. Reconsideration of presently pending claims 1-5, 7-10, 13, 19-27, and 29-30 is respectfully requested in light of the above amendments and the following remarks.

#### **Rejections under 35 U.S.C. §112**

Claims 20-31 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Though the Applicants respectfully disagree with the Examiner's determination, claims 20-31 have been amended to remove the recitation of a "computer readable medium" in order to efficiently advance prosecution. The Applicants kindly request the Examiner withdraw the rejection.

#### **Rejections under 35 U.S.C. §101**

Claims 20-32 were rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Claim 32 has been canceled, and as such, the rejection is moot as to this claim. Claims 20-31 have been amended to be directed to a system and as such, the rejection as to these claims is also moot. The Applicants kindly request the Examiner withdraw the rejection.

#### **Rejections Under 35 U.S.C. §103**

Claims 1-5, 7-8, 13, 16-17 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Yoshida, et al (US Patent No. 6,212,518 hereinafter referred to as "Yoshida") in view of Mir (US Patent No. 6,938,081 hereinafter referred to as "Mir") and in further view of Shapiro, et al (US Patent No. 7,434,048 hereinafter referred to as "Shapiro"). Claims 9 and 10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida in view of Mir and in further view of Shapiro and Kuo (US Publication No. 2005/0021165 hereinafter referred to as "Kuo"). Claims 20-23 and 25-27 were rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida in view of Shapiro. Claim 24 was rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida in view of Shapiro and in further view of Oppedahl, et al (US Patent No. 6,789,092 hereinafter referred to "Oppedahl"). Claims 28-30 were rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida in view of Shapiro and in further view of Kuo. Claim

31 was rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida in view Shapiro and in further view of Mir. Claim 32 was rejected under 35 U.S.C. 103(a) as being unpatentable over Mir in view of Yoshida. The Applicants traverse these rejections on the grounds that the references are defective in establishing a *prima facie* case of obviousness with respect to the listed claims.

In *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007), the Court stated that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *Id.* at 1741 (emphasis added).

As the PTO recognizes in MPEP §2142:

... The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness...

In the present application, a *prima facie* case of obviousness does not exist for the claims for the reasons set forth below.

***1. The Examiner has not shown that all words in the claim have been considered***

MPEP 2143.03 states that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” Quoting *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). However, in the present matter, the Examiner has not shown that all words in claim 1, as amended, have been considered. Claim 1 recites: “wherein the estimation module provides a list of a plurality of customers who are impacted by the revision of the technology process according to a quantitative criteria to represent the overall impact by the revision.”

Thus, for this independent reason alone, the Examiner’s burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

**2. *The Examiner has not shown how the elements being combined are performing their known or established function***

KSR teaches that when combining elements from different references, it is important to determine whether the element is performing “the same function it had been known to perform.” KSR at 1740. It is clear that the method of retrieving information from a database described in Yoshida should not be combined with the method finding a customer impacted by a network infrastructure change and/or the creation of an audit trail described by Shapiro because the known function of each element is changed in the Examiner’s proposed rejection.

More particularly, the Examiner states that Yoshida provides for the claimed “extraction module...configured to search a plurality of process documents and the plurality of technology files...wherein the extraction module determines at least one document within the predefined search scope and the predefined search scheme, wherein the at least one document is one of the plurality of process documents or ...technology files.” OA dated January 7, 2010 at pg. 5. In contrast, the cited portion of Yoshida describes only searching a database and returning a result. The cited portion is reproduced below in its entirety.

The search unit 10 searches the database 2 in response to the search request sent from the user terminal 3, and it sends the result of the search to the user terminal 3 as a reply.

The Examiner states that “from the teaching of Mir, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system and method of retrieval of data from related databases of Yoshida et al. to include and analyzing information and evaluating for an impact to the customer by a revision of the technology process.” OA at pg. 6. However, Mir is directed to changes to network infrastructure and “determin[ing that affected entities] should be notified by a change.” OA at pg. 6. There is no indication, or even suggestion, of evaluating an impact to a customer by a revision of the technology process.

The Examiner further argues that Shapiro “discloses controlling access to electronic documents with the concept of determining who has accessed a document (Col. 4, Lines 43-65, via creating an audit trail which records when a document was accessed, from where, and by whom).” OA at pg. 6. The purpose of Shapiro is to control who accesses a document. There is no indication of using the audit trail of Shapiro as claimed – for example, by an estimation module.

Thus, in summary, the Examiner argues that Yoshida's system of searching databases provides the relevant functionality except that Shapiro provides determining a customer has accessed a document and Mir discloses analyzing information and evaluating for an impact to the customer by a revision. OA at pgs. 5-7. The Examiner further argues that the type of documents being searched and stored "hold little patentable weight in the system claim." OA at pg. 7. First, the Applicants note that claim 1, and the claims that depend therefrom, are directed not just to the existence of process documents and technology files, but the use of such documents. Thus, the Applicants strongly disagree that they add "little patentable weight."

Further, the Examiner is combining the dissimilar disclosures of: a searching system for a database (Yoshida), a system for managing network infrastructure (Mir), and controlling access to a document (Shapiro). Each disclosure is being greatly modified from its intended use. The Applicants submit that the Examiner is, through classic hindsight, using the claims as a roadmap to form his rejection. This is further evidenced by the Examiner's omission of any indication in the art of the process documents or technology files to which the claim is directed.

Thus, since these modifications of the references clearly destroy the purpose or function of the invention disclosed in the patents, one of ordinary skill in the art would not have found a reason to make the claimed modification.

Thus, for this reason alone, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

**3. *The Examiner has not shown how the elements being combined produce a predictable result***

MPEP 2143.01 (III) states that the "mere fact that references can be combined does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art." In the present case, the Examiner has not expressed any reason why combine the systems of Yoshida, Mir, and Shapiro in the way the claimed would present a predictable result.

As described above, each of the references is directed to distinct, unrelated systems. The Examiner takes elements of each system, piecemeal, and using the claims as a roadmap applies bits and pieces of the references in the rejection. There is no indication in any of the cited

references of using any of the disclosed systems to predictably provide an estimation module that analyzes the information of a customer determined by an extraction module, and evaluates for an impact to a determined customer. Thus, for this reason alone, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

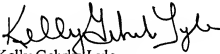
### **Independent Claim 20**

Claim 20 is allowable for substantially the same reasons as discussed above. Furthermore, claim 20 recites "wherein the customer impact estimation system searches according to the search scope and the search scheme, a microelectronics fabrication design technical documents database that includes information related to the technology process to determine a customer impacted by the revision". There is no indication in Yoshida and Shapiro, over which claim 20 stands rejected, as to determining a customer impacted by a revision. For at least this additional reason, the rejection of claim 20 should be withdrawn.

### **CONCLUSION**

An early formal notice of allowance of claims 1-5, 7-10, 13, 19-27, and 29-30 is requested. A personal or telephonic interview is respectfully requested to discuss any remaining issues in an effort to expedite the allowance of this application.

Respectfully submitted,

  
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